

## **REMARKS**

Applicant has carefully reviewed the Office Action mailed July 24, 2007 and offers the following remarks.

Claims 1-16 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,471,519 to Howe et al. (hereinafter "Howe") in view of U.S. Patent Application Publication No. 2002/0076007 A1 to Gibson et al. (hereinafter "Gibson"). Applicant respectfully traverses.

To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. An obviousness inquiry requires looking at a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007). For the Patent Office to combine references in an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have combined the references. *Id.* at 15. If the Patent Office cannot establish obviousness, the claims are allowable.

Before addressing the rejections, Applicant provides a brief summary of the claimed invention so that the remarks are considered in the proper context. The present invention is designed to facilitate monitoring of a hosted voicemail system. Meaning, even though the hosted voicemail system is not directly associated with any customer device, the user may listen as voice messages are being left in the voicemail system and may interrupt the message to answer the call. The claims are focused on an embodiment wherein the calls are directed initially to the voicemail system and then the telephone terminal is alerted to the existence of the incoming call that the called party may wish to monitor. The voicemail system of a service provider, according to the present invention, may be configured to provide the functionality of a conventional answering machine. The user may listen to the voicemail message being left by the caller as the voicemail message is being recorded. At any time during the recording of the voicemail message, the user may engage the call and begin conversing with the caller.

Applicant first submits that Howe and Gibson are not properly combined. Howe teaches away from the present invention. Howe is directed to a method and apparatus for monitoring and controlling communications directed to a called party (Howe, col. 1, lines 6-9). Upon

receiving a communication directed to a called party, the invention of Howe determines the location of the called party and calls the called party at the location (Howe, Abstract; and col. 3, lines 24-47). If the called party picks up the call, then the caller has the option of rejecting the call and routing the call to a message service along with a request to monitor the call (Howe, Abstract; and col. 3, lines 47-64). If the called party does not pick up the call within a predetermined time, the call is routed to the communication service (Howe, col. 3, lines 65-67). Thus, there are two clear teachings in Howe: (1) the call is initially directed to the terminal of the called party, and in fact, the user must answer the call before choosing to monitor the call (Howe, col. 3, lines 47-67; col. 9, lines 44-47; and col. 10, lines 28-31); and (2) the invention of Howe is based on knowing the location of the called party (Howe, col. 3, lines 24-34). Because Howe teaches that the call is initially directed to the terminal of the called party, and in fact, the user must answer the call before choosing to monitor the call, Howe teaches away from the present invention, in which the call is initially directed to the hosted voice mail system. MPEP § 2141.02; *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Since Howe teaches away from the present invention, a person of ordinary skill in the art would not combine Howe with Gibson to reach the claimed invention.

Even if the combination of Howe and Gibson were proper, a point Applicant does not concede, the combination does not teach each and every limitation of the claimed invention. Claim 1 recites that the call is initially directed to the hosted voicemail system before being directed to the telephone terminal. Howe shows the opposite situation (see Howe, Fig. 3A (steps 39 and 40); col. 3, lines 65-67; and col. 9, lines 44-47). The Patent Office admits that Howe does not teach that the call is initially directed to the hosted voicemail system before being directed to the telephone terminal (Office Action mailed July 24, 2007, p. 3). However, the Patent Office asserts that Gibson teaches a system where a call is initially directed to a hosted voicemail system before being directed to the telephone terminal. *Ibid.* Applicant respectfully traverses. Gibson does not teach **initially** directing a call to the hosted voicemail system and then to the telephone terminal.

The Patent Office references paragraphs 0002, 0015, and 0019 of Gibson as allegedly teaching that the call is initially directed to the hosted voicemail system before being directed to the telephone terminal (Office Action mailed July 24, 2007, p. 3). Gibson discloses a voice mail screening system which includes a switching system for receiving a call from a calling party

(Gibson, Abstract). The system also includes a voice mailbox which is coupled to the switching system if the called party does not answer the call. *Ibid.* However, the key difference between Gibson and the present invention is that the call in Gibson is still initially directed to the terminal of the called party. Even according to the description of the system of Gibson in the Abstract, the voice mailbox is coupled to the switching system **if the called party does not answer the call**. Thus, the call is initially directed to the telephone terminal of the called party. This is confirmed by paragraphs 0013 and 0015-0019 of Gibson. In Gibson, the called party at telephone terminal 100 sets voice mail to pick up **after a predetermined number of rings** at the telephony terminal 100 (Gibson, paragraph 0015). Thus, the call is initially directed to the telephony terminal. It is only after the predetermined number of rings that the call is then directed to the voice mailbox via a three-way call. *Ibid.* In fact, it is the telephony terminal 100 that initiates the three-way call (“the telephone 100 performs a flash-hook (i.e., goes off hook), which initiates three-way call”), so the call must go to the telephony terminal first (Gibson, paragraphs 0013 and 0015). It is clear from an examination of paragraphs 0013 and 0015-0019 of Gibson that the call is initially directed to the telephone of the called party and the telephone of the called party initiates a three-way call between the called party’s telephone, the voice mailbox, and the calling party’s telephone. Since the call is initially directed to the telephone of the called party in Gibson, Gibson does not teach “wherein the call is initially directed to the hosted voicemail system before being directed to the telephony terminal,” as claimed in the present invention.

Since Gibson discloses that the call is initially directed to a terminal of the user and is not initially directed to the hosted voicemail system before being directed to the telephone terminal, as recited in claim 1, Gibson does not teach the element for which it is cited. The Patent Office has admitted that Howe does not teach this element. Thus, it is clear that the combination of Howe and Gibson fails to teach or suggest “wherein the call is initially directed to the hosted voicemail system before being directed to the telephone terminal,” as recited in claim 1. Since the combination does not teach or suggest initially directing a call to a hosted voicemail system to facilitate audible call screening in association with a hosted voicemail system, *prima facie* obviousness has not been established. As such, claims 1-19 and 21-33 define patentable subject matter.

Claims 17-19 and 21-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Howe in view of Gibson and further in view of U.S. Patent Application Publication No. 2004/0096046 A1 to Lektion et al. (hereinafter "Lektion"). Applicant respectfully traverses. The standards for obviousness are set forth above.

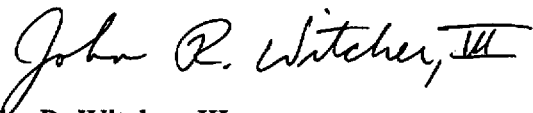
The Patent Office has offered no new arguments with respect to claim 17 other than the addition of Gibson. As set forth above, the combination of Howe and Gibson is not proper, and therefore the combination of Lektion with Howe and Gibson is also improper. Also as discussed above, the combination of Howe and Gibson does not teach each and every limitation of the claimed invention. Lektion does not cure the deficiencies of the combination of Howe and Gibson. Thus, Applicant respectfully submits that this rejection is improper and should be withdrawn for the reasons set forth above, as well as the same reasons previously set forth by Applicant (see Response filed November 3, 2005; Response filed March 10, 2006; the Request for Continued Examination/Response to the Advisory Action filed April 12, 2006; and the Response filed May 8, 2007). As such, claim 17, as well as claims 18, 19, and 21-32, which depend from claim 17, defines patentable subject matter.

In addition, claims 18, 19, and 21-32 were rejected for the same reasons set forth for claims 2, 3, and 5-16, respectively (see Office Action mailed July 24, 2007, p. 11). Since claims 2, 3, and 5-16 were rejected over Howe in view of Gibson, the Patent Office is using Gibson to reject claims 18, 19, and 21-32 as well. As set forth above, the combination of Howe and Gibson does not teach each and every limitation of the claimed invention. For at least the same reasons, the rejection of claims 18, 19, and 21-32 is improper as well.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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